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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,647	09/17/2003	Jindrich Houzvicka	H0610.0351/P351	3795
24998 7590 03/19/2008 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
BOYER, RANDY				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
03/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/663,647	Applicant(s) HOUZVICKA ET AL.
Examiner RANDY BOYER	Art Unit 1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1-5.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Attached.

/Glenn A Caldarola/
Acting SPE of Art Unit 1797

Continuation of 11, does NOT place the application in condition for allowance because:

Applicant's arguments are unpersuasive and insufficient to overcome the rejections made in the Office Action (final rejection) mailed 21 November 2007. Consequently, the claims are rejected as follows:

- (a) Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollstein (US 4,956,519); and
- (b) Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollstein (US 4,956,519).

1. Applicant argues that Hollstein fails to disclose a catalyst composition consisting of oxides of aluminum, zirconium modified with tungsten oxyanion, and a Group VIII metal.

In response to Applicant's argument, Examiner notes wherein Hollstein clearly discloses that his catalyst composition may include (1) mixtures of Group III (e.g. aluminum) and Group IV (e.g. zirconium) metal oxides or hydroxides (see Hollstein, column 2, lines 64-68; and column 3, lines 1-2 and 20-31); (2) oxides or hydroxides of a Group VI metal (e.g. tungsten) (see Hollstein, column 2, lines 53-54; and column 3, lines 3-7) which is prepared with aqueous solutions (e.g. nitrate and sulfate "oxyanions") (see Hollstein, column 3, lines 20-53) containing compounds of such metals; and (3) a Group VIII metal (see Hollstein, column 3, lines 12-19).

2. Applicant argues that the catalyst composition of Hollstein contains a Group VIII oxide or hydroxide, whereas Applicant's catalyst contains a Group VIII metal.

In response to Applicant's argument, Examiner notes wherein Hollstein clearly discloses "the catalysts according to [Hollstein] may be prepared for example by impregnating a support of Group III or Group IV metal oxide or hydroxide with an aqueous solution containing compounds of Group VII and Group VIII metals" (see Hollstein, column 3, lines 12-16).

3. Applicant argues that Hollstein's catalyst is in sulphated form, whereas Applicant's catalyst is unsulfated.

In response to Applicant's argument, none of Applicant's claims specifies wherein Applicant's catalyst is "unsulfated." Moreover, Examiner finds no support in Applicant's disclosure to support the argument that Applicant's catalyst is required to be "unsulfated."

4. Applicant argues that Applicant's process provides a catalyst composition of oxides/hydroxides of aluminum, zirconium being modified with tungsten hydroxide and a metal of Group VIII which is selected from more than 30 possible elements mentioned in Hollstein. Thus, Applicant argues that there is insufficient motivation, suggestion, or teaching of the desirability of Applicant's specific combination to sustain an obviousness rejection.

In response to Applicant's argument, Examiner notes wherein aluminum and zirconium are PREFERRED components of Hollstein's catalyst composition. Moreover, Hollstein requires the presence of a Group V, Group VI, or Group VII metal oxide or hydroxide, with tungsten being one named element (Group VI) out of a total of 13 named elements from these groups. Thus, Hollstein does not disclose the use of tungsten (oxide or hydroxide) as one of hundreds of possibilities, but rather as one of a rather narrow set of catalyst components that is clearly identified, discrete, and finite. In this regard, Examiner notes that the Court has recognized: "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103." KSR Int'l Co. v. Teleflex Inc., 82 USPQ2d 1385, 1397 (U.S. 2007).

RPB

/Glenn Caldarola/